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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,925	09/15/2005	Raymond John Steptoe	18749	8585
272 7590 05/01/2009 SCULLY, SCOTT, MURPHY & PRESSER, P.C. 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
LI QIAN JANICE				
ART UNIT		PAPER NUMBER		
1633				
MAIL DATE		DELIVERY MODE		
05/01/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/527,925

**Applicant(s)**

STEPTOE ET AL.

**Examiner**

Q. JANICE LI

**Art Unit**

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The Remarks filed 2/3/09 are acknowledged. No claim has been amended.

Claims 1-8, 10-16 are pending and under current examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8, 10, 12-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Bochan et al.* (Transplant proc 1999;31:690-1), in view of *Inukai et al.* (*Jpn J Pharmacol* 1993;61:221-7) and *Burt et al.* (Autoimmunity Rev 2002;1:133-8), for reasons of record and following.

In the remarks, the applicant argues that Inukai is directed toward treating and reversing one diabetic complication, not the diabetes itself. Tian is a post-filing art.

The arguments have been fully considered but found not persuasive for reasons below.

1). as indicated previously, it was a common knowledge in the art that prevention and treatment of a disease go hand in hand. For any given treatment regimen, the underlying mechanism for reversing the course of diabetes generally should be the same for prevention. In fact, it is harder to achieve course reversal for a disease than to prevent or reduce the risk of developing the disease. Therefore, when *Bochan* establishes that diabetes has been reversed in experimental animal models, it would have reasonably suggested to the skilled in the art that the approach would have been effective in prevention as well. The applicant fails to provide any factual evidence or reasoning to show this is not true for prevention of diabetes.

2). the neuropathy disclosed by *Inukai* was caused by diabetes, accordingly, when the neuropathy was prevented with a medication, the medication must have some effect on the diabetes.

3). *Tian* was cited as factual evidence to support the general assertion on instant point 1, and hence is not limited by the priority date. The court has established a later

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publication may be used as evidence that the disclosed device would have been operative. *Compare In re Hogan*, 559 F.2d 595,605, 194 USPQ 527, 537 (CCPA 1977) and "FEDERAL DISTRICT COURT DID NOT ERR, ...BY ACCEPTING TESTIMONY OF EXPERT WHO, IN DETERMINING HIS OPINION AS TO WHETHER DISCLOSURE WAS ENABLING AT TIME OF APPLICATION'S FILING DATE, RELIED UPON TECHNICAL ARTICLE THAT WAS PUBLISHED AFTER FILING DATE". *see Gould v. Quigg*, 822 F.2d 1074, 1078, 3 USPQ2d 1302, 1305 (Fed. Cir. 1987).

Accordingly, for reasons of record and *supra*, the rejection stands.

Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Bochan et al* (Transplant proc 1999;31:690-1), in view of *Inukai et al.* (Jpn J Pharmacol 1993;61:221-7) and *Burt et al* (Autoimmunity Rev 2002;1:133-8) as applied to claims 1-8, 10, 12-16 above, further in view of *Slavin et al* (USP 6428782), for reasons of record and *supra*.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Q. JANICE LI** whose telephone number is **571-272-0730**. The examiner can normally be reached on 9 AM -7:00pm, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph Weitach** can be reached on **571-272-0739**. The fax numbers for the organization where this application or proceeding is assigned are **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

For all other customer support, please call the USPTO Call Center (UCC) at **800-786-9199**.

*/Q. JANICE LI, M.D./*  
*Primary Examiner, Art Unit 1633*

*QL*

May 1, 2009